

REMARKS

Reconsideration and allowance of the present application based on the foregoing amendments and the following remarks are respectfully requested.

Claims 1-4, 6-11, and 13-51 are currently pending in the present application. Claims 5 and 12 have been canceled. Claim 51 is a new dependent claims.

Claims 1-7, 16-18, and 22-47 stand rejected as being anticipated under §102(b) over Homeyer. To obviate this rejection, independent claim 1 has been amended to more clearly define the scope of the claimed invention, and differentiate from Homeyer.

In rejecting claims as anticipated under § 102 a reference must teach each and every element of the claim. According to MPEP § 2131:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 has been amended to more specifically recite that “the one or more support members are elongated and extend downwardly from the harness to suspend the receptacle at a position below the wearer’s buttocks when the wearable device is worn in the operative position.” This provides the device with a low center of gravity for purposes of carrying tall, elongated objects. Specifically, by having the receptacle suspended by elongated supports so as to be positioned below the wearer’s buttocks, the elongated object (*e.g.*, a pair of skis) is held at a much lower position on the wearer’s body. *See* Application at paragraph [0033] (discussing positioning of object on user’s back). This is a much more comfortable position that if the bottom of the skis were supported at the wearer’s waistline, which means that a large extent of the skis will extend above the wearer’s head, and the center of gravity will be high on the wearer’s back and can cause discomfort.

The claimed invention is particularly advantageous for backcountry skiers that have to hike up or across mountains to access desirable backcountry terrain. This increased comfort makes these hikes easier on the wearer’s back, and leaves them more energized for the actual backcountry skiing upon reaching their destination.

Homeyer does not teach this claimed construction. At best, Homeyer teaches a backpack style harness that has a receptacle for carrying an elongated object. However,

Homeyer does not have “one or more support members attaching the receptacle to the harness so as to suspend the receptacle below the one or more retainers and the harness when the wearable device is worn in the operative position.” And moreover Homeyer does not have “one or more support members” that are “elongated and extend downwardly from the harness to suspend the receptacle at a position below the wearer’s buttocks when the wearable device is worn in the operative position.”

The Examiner alleges that straps 6 and 7 of Homeyer correspond to the claimed “one or more support members attaching the receptacle to the harness.” This is inaccurate, as straps 6 and 7 are shoulder straps, and thus are part of the harness itself. They are not separate support members that attach a receptacle to the harness. And even if they were, they clearly do not extend “downwardly from the harness to suspend the receptacle at a position below the wearer’s buttocks when the wearable device is worn in the operative position.”

Indeed, an important feature of the Homeyer device is to enable the device to be worn while riding an ATV or on horseback. As such, Homeyer identifies the importance of positioning the carried equipment “high enough on the wearer’s back to allow him to be seated on an ATV or on horseback without having the equipment touch the vehicle seat or frame or the horse’s back or saddle, thereby reducing or eliminating the effect of vehicle vibrations and jolts on the equipment.” Homeyer at column 2, lines 18-23. *See also*, Homeyer at column 1, lines 26-35, and column 2, lines 37-41 (discussing issues with riding ATV or horseback, and identifying convenient carriage of an item as being an “object of the invention.”) This is the exact opposite of the Applicants’ invention, which seeks to lower the positioning of the elongated object carried by the wearer. Thus, Homeyer and the Applicants have approached their respective devices from different angles taking into account different ergonomic factors, and as such have arrived at entirely different solutions.

For at least these reasons, the Applicants submit that claim 1 is patentable over Homeyer, and respectfully request the Examiner to withdraw his outstanding anticipation rejection.

Claims 2-4, 6-11, and 13-48 depend from claim 1 and are submitted to distinguish from the art of record for at least the reasons advanced above with respect to claim 1, and for the additional reason that they each recite additionally patentable features.

For example, claim 6 recites that “the one or more elongated support members includes a plurality of flexible straps connected between the main body and the receptacle,” and claim 7 recites that “each of the flexible straps have length adjusters to enable adjustment of a distance at which the receptacle is suspended below the main body when the wearable

device is worn in the operative position.” Homeyer does not teach any length adjuster for adjusting straps that extend below the below main body (and support the receptacle below the wearer’s buttocks as recited in claim 1). Thus, relying on Homeyer to reject claim 7 is improper because the full combination of elements is not taught in Homeyer.

Likewise, dependent claim 9 recites the capability to vertically adjust the distance at which the receptacle is suspended below the harness. It would be undesirable in Homeyer to provide this adjustability in a device where the receptacle is located below the wearer’s buttocks, because in the first place it is undesirable in the Homeyer device to have the receptacle that low (see discussion above). Thus, it would make no sense to further provide adjustability. Moreover, Jensen is an unrelated reference and has no teachings about adjustability for the types of devices which the claimed invention is used to carry.

Independent claim 49 stands rejected as being obvious under §103 over Mullen and Homeyer. The Applicants respectfully request the Examiner to reconsider this rejection.

As set forth in M.P.E.P. §2143, to establish a *prima facie* case of obviousness, the Examiner must meet three basic criteria:

1. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
2. There must be a reasonable expectation of success.
3. The prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Applicant submits that the Examiner has at least failed to establish a motivation or suggestion for combining the two Mullen and Homeyer references together as asserted, and thus has failed to establish the first prong of the above obviousness test. Under the three-pronged obviousness test, the first prong requires the Examiner to establish that the prior art provides a teaching or suggestion to one of ordinary skill in the art to combine the cited references to produce the claimed invention. See In re Fine, 837 F.2d 1072 (Fed. Cir. 1988) (holding that the Board of Patent Appeals & Interference erroneously upheld rejection of claims where prior art references failed to disclose a material limitation of the claims and that there was no evidence supporting the Board’s assertion that the art showed a motivation or suggestion to combine references); see also M.P.E.P. §2143.03. It is not sufficient to simply

cite references that are capable of being combined to establish the *prima facie* case of obviousness; instead the Examiner establish a motivation or suggestion to combine the references as asserted. See In re Mills, 916 F.2d 680 (Fed. Cir. 1990); see also, M.P.E.P. §2143.01. Further, the Examiner is required to cite evidence, either in the references themselves or in the knowledge generally available to one skilled in the art, to support his assertions underlying the *prima facie* case of obviousness. See In re Werner Kotzab, 217 F.3d 1365, 1371 (Fed.Cir. 2000). This applies to all the elements of the *prima facie* case of obviousness, including establishing a motivation or suggestion to combine references.

The mere fact that a prior art reference can be modified is not sufficient to establish the *prima facie* case of obviousness. See In re Mills, 916 F.2d 680, 682 (Fed.Cir. 1990) (stating that although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”).

M.P.E.P. §2144.03 provides that the “rationale supporting an obviousness rejection may be based on common knowledge in the art or ‘well-known’ prior art.” However, this section does not relieve the Examiner of his obligation to support such assertions by objective evidence if challenged by the Applicant. In Application of Alhert, the CCPA stated:

Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. . . . Allegations concerning specific “knowledge” of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge. 424 F.2d 1088, 1091 (1970) (citations omitted).

Here, the Applicants submit that the Examiner lacks the requisite motivation to combine the two asserted references. As an initial matter, Mullen does not relate at all to a wearable device that carries an object on a wearer’s back. Instead, it has a safety device that attaches a person to an object. For example, the straps on the device may be used to couple the wearer to a tree while in a hunting stand to prevent an accidental fall. This has nothing to with carriage of elongated objects on the wearer’s back.

Therefore, it cannot be suggested that one would modify the device of Mullen to provide for carriage of an elongated object on a wearer’s back. Indeed, to do so would defeat the very purpose of Mullen. If Mullen were modified so that its straps were used for carrying an elongated object, then it could not be used as a safety device – which is its very purpose.

To modify a reference in such a manner to defeat its essential teachings is not legally permissible and cannot support an obviousness rejection. See MPEP § 2143.01. See also, In re Ratti, 270 F.2d 810 (CCPA 1959) (reversing rejection because combination of references would change the basic principle under which the primary reference was designed to operate).

Additionally, in addition to defeating the purpose of the Mullen device, such a combination would also eliminate an advantage of the Homeyer device. Specifically, Homeyer identifies as an advantage that a rifle or shotgun “while the carrier is still engaged on it.” While it would be theoretically possible to do so in the invention of claim 49, it would obviously be very inconvenient to aim and fire a rifle with a garment attached to it, as opposed to the strap based harness of Homeyer. Thus, one viewing Homeyer and understanding this advantage would not be motivated to add a garment. This is also contrary to the combination of references advanced by the Examiner.

There is no reason to combine these references where each would lose their stated functionality and advantages. Indeed, in view of their teachings, the Applicants submit that one of ordinary skill in the art would leave their constructions alone and unmodified so that these functions and advantages can be utilized.

Moreover, there is no other rationale offered by the Examiner for combining the asserted references. The only support for the Examiner’s position is the conclusory statement as follows: “It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the one or more support [sic] on the harness as taught by Homeyer with the internal harness of Mullen in order to allow the user to transport elongated items safely while wearing protective clothing.” Office Action at end of section 6 (addressing claim 49). A similar conclusory rationale was provided for claim 50. Office Action at end of section 7. However, there is no evidence in the record that supports this conclusion. And objective evidence of statements in support of the Examiner’s *prima facie* obviousness case is required. See In re Werner Kotzab, 217 F.3d at 1371. That evidence is simply lacking, and the Examiner appears to be relying on mere conclusion.

At best, the Examiner appears to be arguing that Mullen’s garment with an internal harness is capable of combination with the device of Homeyer. However, as noted above, the mere fact that a prior art reference can be modified is not sufficient to establish the *prima facie* case of obviousness. See In re Mills, 916 F.2d 680 at 682. Without a motivation for combining the reasons, and in particular objective evidence teaching such a motivation, the

Applicants submit that the Examiner has engaged in a hindsight reconstruction of the Applicants' invention using the Applicants' own teachings.

Accordingly, claim 49 is submitted to patentably distinguish from the Mullen and Homeyer combination asserted by the Examiner, and the Examiner is respectfully requested to withdraw his outstanding obviousness rejection.¹

Claims 50 and 51 depend from claims 49 and are submitted to distinguish from the art of record for at least the reasons advanced above with respect to claim 49, and for the additional reason that they each recite additionally patentable features. Moreover, claims 50 and 51 recite the features discussed above with respect to claim 1, and are submitted to be patentable for those reasons.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly requested.

If the Examiner has any questions concerning this response, or the application in general, he/she is encouraged to contact the undersigned at the below-listed phone number to help facilitate prosecution of this application.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP



BRYAN P. COLLINS
Reg. No. 43560
Tel. No. 703.770.7538
Fax No. 703.770.7901

BPC/smm
P.O. Box 10500
McLean, VA 22102
(703) 770-7900

¹ The same arguments apply to claim 48, which depends from claim 1, and recites an outer garment and internal harness.